

### **REMARKS**

This document is a response to the Office action mailed on January 15, 2008.

The Examiner designated the Office action of January 15, 2008 as "final," indicating that the applicant's amendment necessitated the new ground(s) of rejection (*Office Action of January 15, 2008, page 5*).

A telephone interview, a record of which is being submitted concurrently herewith, was conducted on March 3, 2008 between applicant's representative Dmitry Andreev and Examiner Thanh X. Luu. During the interview, applicant's representative asserted that the "final" status of the Office action dated January 15, 2008 should be removed since in the January 15, 2008 Office action, several claims have been rejected for the first time over a full translation of JP 62-139465 to Azuma et al. ('Azuma'), while in the previous Office action the claims were rejected over an abstract of the same reference. The applicant's representative noted that on at least two occasions the Court of Appeals for Federal Circuit (the "CAFC") has held that an abstract of a foreign publication and a full translation of the same publication were different references for the purposes of finding inequitable conduct on the part of the applicant for failing to submit a full translation<sup>1</sup>.

In response, the Examiner stated that he did not rely on the full translation of Azuma for the claim rejections. The applicant's representative disagreed, noting that the plain language of the Office action referred to the full translation of Azuma. The Examiner offered to remove the references to the full translation while keeping the final status of the Office action.

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<sup>1</sup> While the two CAFC cases were not specifically referenced in the Interview for purposes of reducing the time of the interview, a concise summary is provided herein. In *Semiconductor Energy Laboratory v. Samsung Electronics*, 204 F.3d 1368 (Fed. Cir. 2000), CAFC upheld the district court's finding that failure to submit a full translation of a Japanese publication was inequitable conduct on the part of the applicant notwithstanding the fact that a partial translation and a full Japanese original have been timely submitted. In *Atofina v Great Lakes Chemical Co.*, 441 F.3d 991 (Fed. Cir. 2006), CAFC revisited the issue of whether inequitable conduct can be found where the applicant failed to submit a full translation of a foreign reference. While CAFC reversed the district court's finding of inequitable conduct, the reversal was based on the lack of clear and convincing proof of the applicant's deceptive intent, which, the Court held, could not be inferred from "the applicant's failure to disclose the full English translation of a foreign reference ... even if the full English translation went beyond the ... abstract." However, the mere fact that CAFC discussed the intent element at length, shows, in the applicant's opinion, that the Court saw an abstract and a full translation as potentially being two different references.

The applicant respectfully re-iterates that, under the cited CAFC opinions, a full translation of a foreign reference is a "new" reference as compared to the abstract of the same foreign reference, and hence, the Examiner is respectfully requested to remove the final status of the January 15, 2008 Office action.

The applicant further respectfully asserts that the final status of the Office action of January 15, 2008 is also improper under *MPEP* §706.07(a), since the Office action includes rejections on prior art not previously of record (U.S. Patent No. 4,823,277 to Reed) of claims 109-120, while these claims included previously claimed subject matter and subject matter that should reasonably have been anticipated to be claimed. *MPEP* §706.07(a) is respectfully brought to the Examiner's attention:

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See *MPEP* §904 *et seq.*

While *MPEP* does not explicitly state what should be considered as "claim limitations which should reasonably have been anticipated," *MPEP* §706.07(a) includes an explicit reference to *MPEP* §904 *et seq.* In turn, *MPEP* 904 requires that "the first search should cover the invention as described and claimed, including the inventive concepts toward which the claims appear to be directed." Furthermore, *MPEP* 904.03 directs the Examiner:

[i]n doing a complete search, [to] find and cite references that, while not needed for treating the claims, would be useful for forestalling the presentation of claims to other subject matter regarded by applicant as his or her invention.

Thus, the limitations which should reasonable have been expected to be claimed need not be found in the previously presented claims (*MPEP* 904.03 quoted above), provided that the subject matter for the limitations has been described in the application and regarded by the applicant as his invention (*MPEP* 904 quoted above).

The applicant respectfully submits that the limitations of claims 109-120 have been either present in the previously presented claims, or should have been reasonably anticipated to be claimed since the subject matter reflected in the claim limitations is regarded by the applicant as his invention and has been prominently described in the specification.

Hence, the Examiner is respectfully requested to remove the final status of the Office Action of January 15, 2008 and enter the present Amendment as an Amendment in response to a non-final Office Action.

Further, the Examiner imposed a restriction requirement contending that

[n]ewly submitted claims 121-127 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the previous claims do not mention alignment indicated by an electrical signal. *Office Action of January 15, 2008, page 2.*

The applicant respectfully traverses the restriction requirement by asserting that even if the purported legal standard applied by the Examiner to determine whether a restriction requirement should be imposed, was correct (which the applicant maintains it was not), the Examiner failed in applying the purported standard: despite the Examiner's statement that "the previous claims do not mention alignment indicated by an electrical signal" (which was offered as the only reason for imposing the restriction requirement), claim 25 of the present application (which has been previously cancelled without prejudice or disclaimer, but nevertheless was subject to a complete search and examination) included a limitation of "observing indicia representing electrical signals generated by said image sensor."

The applicant further respectfully asserts that since the subject matter under the currently imposed restriction requirement has been previously subject to search and examination, the Examiner has not established the serious burden as required under *MPEP* § 803. Since the two criteria for a proper restriction requirement set forth in *MPEP* § 803 are conjunctive, failure to establish either of the two criteria makes a restriction requirement improper under *MPEP* § 803. Hence, the Examiner is respectfully requested to withdraw the restriction requirement and the ensuing constructive election.

With respect to the claim rejections, claims 76-79 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner will note that the applicant cancelled claims 76-79 without prejudice or disclaimer. As it is emphasized that such cancellation is without prejudice or disclaimer, the applicant reserves the right to pursue claims directed to the subject matter of the cancelled claims 76-79 in a related application (e.g., a continuing application).

Claims 73-75, 77, and 78 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent JP62-139465 to Azuma et al. ('Azuma').

The applicant respectfully asserts that the Examiner improperly grouped claims 73-75, 77, and 78 in a common rejection (*Office action of January 15, 2008, page 3*) contrary to the MPEP provision stating that "[a] plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group." *MPEP §707.07(d)*.

According to *MPEP §2131*, "to anticipate a claim, the reference must teach every element of the claim." A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)

In order to expedite allowance, the applicant amended independent claim 73 without prejudice or disclaimer. Support for the amendment of claim 73 can be found, e.g., in paragraphs [0028]-[0029] of U.S. Patent Publication No. 2002/0066851. It is believed that claim 73 in its amended form is patentable over Azuma since Azuma at least fails to teach or suggest the element of a planar solderable surface, in combination with numerous additional elements of claim 73.

Regarding dependent claims 74-75 and 109-110, the dependent claims are believed to be allowable at least for their dependence on an allowable base claim 73, and for additional combination of elements the claims recite.

Claims 109-116, 118, and 119 have been rejected under 35 USC §103(a) over Azuma, in view of U.S. Patent No. 4,823,277 to Reed ('Reed').

The applicant respectfully asserts that the Examiner improperly grouped claims 109-116, 118, and 119 in a common rejection (*Office action of January 15, 2008, page 3*), contrary to the MPEP provision stating that "[a] plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group." *MPEP §707.07(d)*

To determine obviousness under 35 USC §103(a), "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007) quoting *Graham v. John Deere Co., of Kansas City*, 383 U.S. 1 (Sup. Ct. 1966)

In order to expedite allowance, the applicant amended independent claim 111 without prejudice or disclaimer. Support for the amendment of claim 111 can be found, e.g., in paragraphs [0028]-[0029] of U.S. Patent Publication No. 2002/0066851. It is believed that claim 73 in its amended form is patentable over Azuma since Azuma at least fails to teach or suggest the element of said image sensor subassembly and said optical subassembly being fixedly adhered to one another, in combination with numerous additional elements of claim 111. Furthermore, Azuma teaches away from the quoted claim limitation, by inserting at least a washer between the surfaces of the two subassemblies (see Azuma, Figs. 8-9 and description: washers 15 are inserted between PCB 8 and optomount 7).

Regarding dependent claims 112-120, the dependent claims are believed to be allowable at least for their dependence on an allowable base claim 111, and for additional combination of elements the claims recite.

The applicant's selective treatment and emphasis of independent claims of the application should not be taken as an indication that the applicant believes that the Examiner's dependent claim rejections are otherwise sufficient. Applicant expressly reserves the right to present arguments traversing the propriety of the dependent claim rejections later in the prosecution of this or another application.

Further, the Examiner will note that applicant has added new claims 128-136. New independent claim 128 is believed to be allowable in that it recites at least the

following element not taught or suggested by the prior art of record: the image sensor subassembly and said optical subassembly being fixedly adhered to one another, in combination with numerous additional elements of claim 128. New dependent claims 129-136 are believed to be allowable at least for their dependence on an allowable base claim 128, and for additional combination of elements the claims recite.

The applicant's highlighting of a particular claim element should not be taken to indicate that the applicant has asserted an argument in support of patentability that a particular claim element constitutes the sole basis for patentability out of the context of the various combinations of elements of the claim or claims in which it is present. The applicant notes that applicant maintains the right here forward to assert that each claim is patentable by reason of any patentable combination recited therein.

No amendment presented herein contains new matter.

Accordingly, in view of the above amendments and remarks, the applicant believes all of the claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

If the Examiner believes that contact with the applicant's attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call the applicant's representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Dated: March 5, 2008

DA/slp

Respectfully submitted,

By 

Dmitry Andreev

Registration No.: 57,428

MARJAMA MULDOON BLASIAK & SULLIVAN LLP

250 South Clinton Street

Suite 300

Syracuse, New York 13202

(315) 425-9000

Customer No.: 20874